IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Thrane

Serial No.: 09/691,775

Filed: October 18, 2000

Customer No.: 29683

Atty. Docket:

NC30507

Art Unit: 2176

Examiner: Nguyen, Chau T.

Confirmation No.: 4383

Title: Method and Apparatus for Content Transformation for Rendering Data into a Presentation Format

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in reply to the Examiner's Answer mailed November 21, 2005.

Claims 1 and 13

An issue in this appeal is whether combining the teaching of the Boag patent with the teaching of the Yalcinalp patent overcomes a deficiency identified by the Examiner in the Yalcinalp patent, *i.e.*, the Yalcinalp does not teach "performing a intermediate stage content transformation using said first stage data layout to generate a intermediate data layout; and performing a final stage content transformation using said intermediate data layout to generate a presentation format based on a device used

by said client" as required by independent claims 1 and 13. The Examiner has repeatedly admitted at each stage of prosecution that the Yalcinalp patent neither describes nor suggests "performing a intermediate stage content transformation . . ."

The Examiner has never identified with specificity exactly where the Boag patent describes or suggests "performing a intermediate stage content transformation . . ." which would overcome the admitted deficiency of the Yalcinalp patent. Instead, the Examiner has repeatedly referred to a summary description of the Boag teaching devoid of implementation detail and concluded that an intermediate stage (an implementation detail) would naturally result were the teaching of Boag and Yalcinalp to be combined as stated, for example, at page 4, line 17 – page 5, line 5 of Examiner's Answer:

> "Since Boag discloses a method for dynamically determining the most appropriate location for applying style sheets on a client request depends on the capabilities of the client device, which is similar to processing a user request document to a transformed document and formatting the transformed document specific to the client specification of Yalcinalp, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boag and Yalcinalp to include performing a intermediate stage content transforming using the first stage data layout to generate a intermediate data layout to provide a technique for increasing the applicability of style sheets when a style sheet tailored to a particular target environment is not readily available."

In other words, the Examiner identifies an alleged basis for combining the references based on the desirability of a result that would be achieved and then concludes that when the combination is made an implementation detail associated with the

combination must be made in a way that is only taught by Appellant's disclosure. This is the epitome of improper hindsight.

The problem with this conclusion is that even if there is a motivation to combine the references in the manner of the Examiner (which Appellant does not admit is the case), Appellant has already identified how the teaching of the Boag reference could be combined with Yalcinalp in such a way that does not result in "performing a intermediate stage content transformation . . ." as required by Appellant's claims. Examiner has never addressed Appellant's suggested manner of combination which is based on implementation details actually disclosed in the Yalcinalp patent.

In regard to the rejection of claims 1 and 13, the Examiner has never adequately addressed Appellants' argument that the disclosure of the Boag patent may be combined with the Yalcinalp patent without modifying the Yalcinalp patent to perform "a intermediate stage content transformation using said first stage data layout to generate a intermediate data layout." As stated repeatedly throughout this prosecution, the style sheet in Yalcinalp may have embedded an external call to perform a document transformation as described at, for example, Column 6, lines 14 – 16:

> "The method then proceeds to generate a transform document using the style sheet and an external call embedded in an external component in the style sheet (step 305)."

Boag admits that in certain instances a style sheet may not exist for tailoring a document for rendering on, for example, a new device. Boag states at Column 10,

lines 26 – 29 "By invoking a general purpose transcoding engine, the present invention may be used advantageously with a new device type for which no specific style sheets are yet available." When combining the teaching of Boag with Yalcinalp, instead of concluding that the transcoding engine may be invoked by a feature that is already disclosed in Yalcinalp – for example, the transcoding engine of Boag may be invoked by an external call embedded in an external component in the style sheet of Yalcinalp – the Examiner modifies the Yalcinalp reference to perform the transcoding operation in the context of an intermediate transformation step when the Examiner has already admitted that the Yalcinalp reference does *not* disclose an intermediate transformation step.

Respecting Examiner's Response to Appellant's arguments in this regard presented at page 9, line 14 – page 11, line 17, Appellant respectfully notes that it not until page 11, lines 5 – 17 that Examiner actually addresses Appellant's arguments – the remaining portion concerns issues not in dispute. The arguments presented at page 11, lines 5 – 17 of Examiner's Answer are unavailing because they do not address Appellant's arguments. How the Boag teaching is practiced in the system of Yalcinalp is an implementation detail already accommodated by a teaching of Yalcinalp. It is not necessary to suppose the introduction of an operation of "performing a intermediate stage content transformation . . ." in order to practice the teaching of Boag in the system of Yalcinalp.

In essence, all Appellant is asking is that the Examiner be held to his word, that the Yalcinalp patent does not teach "performing an intermediate stage content transformation," and that any teaching from Boag that may be combined with

Yalcinalp be incorporated in such a way that Yalcinalp already accommodates. Since the embedded call of Yalcinalp admittedly does not constitute "performing an intermediate stage content transformation . . .", when the teaching of Boag is combined with the embedded call of Yalcinalp no such intermediate stage content transformation results.

In addition, Examiner has not addressed an argument presented by Appellant indicating that Boag teaches away from introduction of an intermediate stage content transformation step. In particular, Examiner did not address the argument presented at page 18, lines 12 – 22 of the Appeal Brief. The Boag patent teaches away from performing a distinct intermediate stage content transformation as in the case of Appellant's invention as shown at Col. 11, lines 12 – 16:

> "(When a sequence of style sheets is to be applied to perform a complex transformation, the technique disclosed in the first related invention will preferably be used to chain the multiple style sheets together. The modified reference in the input document is then a reference to where the chained style sheets are cached.)"

There is no teaching in Boag as to how the cached style sheets would be applied, leading one to conclude that they would be applied at the same time. In such an approach a distinct intermediate stage content transformation would not be performed. If the Examiner disagrees, Appellant respectfully requests that the Examiner identify exactly where the problems with such an approach are appreciated and where the performance of an intermediate stage content transformation is discussed in Boag. In conclusion, if the Yalcinalp patent does not disclose a distinct intermediate stage content transformation, and the Boag patent teaches away from it, then how can an

intermediate stage content transformation result from the combination of the Yalcinalp and Boag patents?

The foregoing arguments are equally applicable to claims 1 and 13, and if decided in Appellant's favor, are determinative. The following arguments are applicable to claim 13.

Claim 13

Regarding Examiner's points (a) and (b), Appellant respectfully notes that claim 13 is directed to a *server*, and that all the content transformation steps recited in claim 13 are performed by the *server*. As stated by the Examiner repeatedly in response to Appellant's arguments "Since Boag discloses a method for dynamically determining the most appropriate location [as between a server and a client] for applying style sheets on a client request depends on the client device . . ." (Examiner's Answer, page 4, lines 17 – 19) content transformation operations performed in accordance with Boag may be performed in a *client* device.

Accordingly, the combination of Boag and Yalcinalp results in a system which includes means for determining where to apply style sheets. Appellant's invention simply does not operate in this manner. In such a combination, style sheets may be applied at the client. An object of Appellant's invention (see page 2, lines 15 – 18) is to perform content transformation operations so that dynamic content independent of client limitations is created by a server and provided to a client. In contrast, the method and system of Boag offloads content transformation operations to a client

when appropriate; in other words, in certain instances the server of Boag does not provide dynamic content. The only way to avoid this outcome is to re-design the system of Boag so that all operations are performed by the server. As Examiner already knows, this would defeat the whole purpose of Boag's purported invention which is to determine where, as between the client and server, to apply style sheets.

Regarding Examiner's argument presented at point (c), Appellant has not attacked references individually where the rejection is based on a combination of references. As set forth above, Appellant has presented detailed arguments attacking the *combination* of Boag and Yalcinalp.

In view of the arguments presented above, it is respectfully requested that the

Examiner's rejection of claims 1 – 23 be reversed.

Respectfully submitted,

January 20, 2006   _David M. O'Neill (35,304)_

Date   David M. O'Neill (35,304)

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January 20, 2006   _David M. O'Neill_

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